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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,250	02/19/2004	James M. Murphy	PU2193	2249

23454 7590 10/05/2005

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EXAMINER	
LEE, EDMUND H	
ART UNIT	**PAPER NUMBER**
1732	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/708,250	MURPHY ET AL.	
	Examiner	Art Unit	
	EDMUND H. LEE	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-3 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2/19/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "a sole component" (cl 2,ln 10) is indefinite because it is unclear if it is or is not the sole component mentioned in the preamble.

The phrase "the first plurality of plies of pre preg sheets" (cl 2, lns 20-21) is confusing because it appears that the word --compressed-- should be inserted before the word "first".

The phrase "the first plunger head" (cl 2, ln 23) is confusing because it should be the second plunger head.

The phrase "the sole component" (cl 2, ln 29) is confusing because it is unclear to which sole component is being referred, i.e., the component mentioned in the preamble, the component mentioned in line 10, or the component mentioned in lines 27-28.

Clarification and/or correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

> granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Viollaz et al (USPN 5377986). Viollaz et al teach the claimed process as evidenced by col 5, lns 37-52; and figs 17-20.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Murphy et al (USPN 6607623). Murphy et al teach the claimed process as evidenced by col 8, lns 50-65 and fig 21.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being obvious over Murphy et al (USPN 6607623).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Murphy et al teach all of the claimed limitations expect forming a sole component; using the claimed plunger head; using a second plunger head that is smaller than the first plunger head. In regard to forming a sole component, it is well-known in the golf art to compression mold face and sole components. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mold a sole component by the process of Murphy et al in order to form a strong yet light sole component. In regard to using the claimed plunger head, such is a mere obvious matter of choice dependent on equipment availability and of little patentable

consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed plunger head is well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed plunger head in the process of Murphy et al in order to ensure proper compressing without damaging the plies of pre-preg. In regard to using a second plunger head that is smaller than the first plunger head, such is well-known in the molding in order to form a more compressed area. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a second plunger having a smaller head than the head of the first plunger in order to form a more compressed area of the article.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Viollaz et al (USPN 5377986) in view of Nelson et al (USPN 5985197). Viollaz et al teach the basic claimed process including a method of forming a face component for a golf club (col 5, lns 38-52; figs 17-20); placing a plurality of plies of pre-preg in a mold cavity (col 5, lns 38-52; figs 17-20); lowering a plunger head along a longitudinal axis toward the cavity, the plunger head configured to compress the plies into a face component (col 5, lns 38-52; figs 17-20); compressing the plies with the plunger head to form the component (col 5, lns 38-52; figs 17-20); and removing the component from the mold cavity (col 5, lns 38-52; figs 17-20). Viollaz et al, however, do not teach forming a crown component. Nelson et al teach using pre-preg preforms in the shape of crown components to form a composite golf club (table 1). Viollaz et al and Nelson et al are combinable because they are analogous with respect to composite golf clubs. Thus, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the mold cavity of Viollaz et al to have the shape of a crown component since there is a demand for composite crown components as evidenced by Nelson et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL

10/1505